

REMARKS

Claims 1, 2, and 4-16 are pending in the present application.

Applicants wish to thank Examiner Slobodyansky for the helpful and courteous discussion with their undersigned Representative on January 30, 2004, in which the Examiner indicated that the Office Action of February 9, 2004 would be issued. Also during this discussion, various amendments and new claims were discussed to address the rejections currently of record. The content of this discussion is reflected in the amendments and comment provided herein.

New Claims 7-16 are within the scope of the elected invention and should be examined along with Claims 1-3. Moreover, Claims 7-16 correspond to specific embodiments of previously presented Claims 1-3. Therefore, the subject matter embraced by Claims 7-11 and 13-16 has already been examined on the merits. In regard to Claim 12, Applicants note that this claim is narrower than previously examined Claim 1 and recites specific “stringent conditions.” Accordingly, none of the newly added claims constitute new issues for consideration and, thus, entry and consideration of the same is respectfully requested.

The rejection of Claims 1-3 under 35 U.S.C. § 112, first paragraph (“enablement”) is obviated by amendment.

This ground of rejection was based on the recitation of “a protein that is encoded by a DNA which hybridizes with a DNA having the nucleotide sequence defined in SEQ ID NO: 15 under stringent conditions, and *wherein said protein is at least 70% homologous* to a

protein having amino acid sequence defined in SEQ ID NO: 16 and wherein said protein has a N-acetylglutamate synthase activity.” The Office has taken the position that the specification does not enable the skilled artisan to identify mutant proteins with as little as 70% homology to SEQ ID NO: 16.

Accordingly, Applicants have amended Claim 1 to remove the objectionable language. Based on Applicants’ undersigned Representative’s discussion with the Examiner on January 30, 2004, Applicants have amended alternative (b) of Claim 1 to recite the specific hybridization conditions. Applicants wish to thank the Examiner for this kind suggestion.

Applicants submit that the claims as presented are in full accord with the enablement requirement of 35 U.S.C. §112, first paragraph. MPEP §2164.04 states:

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

At page 9, line 19 to page 10, line 6, Applicants provide a detailed description of the hybridization conditions. At page 14, line 5 to page 20, line 20, Applicants provide a detailed explanation of how the skilled artisan may clone, express, and characterize the proteins within the scope of Claims 1-3. In addition, Applicants refer the Examiner to page 7, line 3 to page 10, line 14, which further defines the mutant NAGS and methods of making the same.

Based on the foregoing, Applicants submit that the present claims are fully enabled by the specification and the common knowledge available in the art and as such withdrawal of this ground of rejection is requested.

The rejection of Claims 1-3 under 35 U.S.C. §112, second paragraph, is obviated by amendment.

Consistent with the Examiner's kind suggestions, Applicants have amended Claims 1 and 2 to clarify and/or remove the objectionable language. In regard to the "stringent conditions," Applicants have defined the same based on the disclosure in the specification at page 9, line 19 to page 10, line 6. The remaining objected to language has been removed from the claims.

Applicants request withdrawal of this ground of rejection.

The rejection of Claims 1-3 under 35 U.S.C. §112, first paragraph (new matter), is obviated by amendment. Applicants make no statement regarding and in no way acquiesce to this ground of rejection; however, Applicants have removed the objectionable language from Claim 1. Therefore, this ground of rejection is no longer believed to be relevant and its withdrawal is requested.

Finally, the Examiner has indicated that Claims 4-6 have been withdrawn.

Applicants remind the Examiner that MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim *will* be rejoined. (*emphasis added*)

Upon a finding of allowability of the elected product claims, Applicants respectfully request rejoinder, and allowance, of the withdrawn process claims (Claim 6).

Further, Applicants note that Claims 4 and 5 depend from Claim 1 and, therefore, relate to share the same point of novelty (the mutant N-acetylglutamate synthase of Claim 1).

Accordingly, Applicants request rejoinder and allowance of Claims 4 and 5 concomitant with allowance of Claim 1.

Applicants submit that the present application is in condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

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